

**REMARKS**

Applicants' undersigned attorney thanks the Examiner for his comments. Applicants respectfully request reconsideration of this patent application, particularly in view of the following remarks. Currently, Claims 1-44 are pending.

**Claim Rejections - 35 U.S.C. §103**

The rejection of Claims 1-44 under 35 U.S.C. §103(a) as being unpatentable over Dailey et al. (U.S. Patent No. 5,036,551) in view of Dobrin (U.S. Statutory Invention Registration H1750) in view of Kitamura et al. (U.S. Patent No. 4,829,096) is respectfully traversed.

**A. Applicants' claims require that each zone of differential breathability comprises a portion of the film and a portion of the nonwoven facing material.**

One factor in establishing a prima facie case of obviousness is that the prior art references, when combined, must teach or suggest all the claim limitations. Kitamura et al., alone or in combination with Dobrin and/or Dailey, does not disclose or suggest a laminate wherein *each of the zones of differential breathability comprises a portion of the film and a portion of the nonwoven facing material*.

On pages 6-7 of the Office Action, in response to Applicants' argument that the references do not suggest that each of the first and second zones of breathability comprises a portion of the film and a portion of the nonwoven facing material, the Examiner states "Applicant's assertion that Dobrin fails to teach the claimed film and facing material is moot because Dailey is relied upon, and clearly teaches, the claimed film and facing material."

The Examiner appears to have missed Applicants' point. Applicants' argument is not that Dobrin, or Dailey, fails to teach the claimed film and facing material. Applicants' argument is that Dobrin does not teach that each of the zones includes a portion of the film and a portion of the nonwoven facing material. This claim limitation is clearly missing in Dobrin. The first breathable zone 82 comprises the outer layer (the nonwovven facing layer) and the inner layer (the film). However, the second breathable

KCC-2059 9 MMC/I

zones 80 comprise only the outer layer (the nonwoven facing) (Col. 9, lines 18-22, and Fig. 3). Although Dobrin discloses different breathable zones, not all of the zones include both a portion of the film and a portion of the nonwoven.

Additionally, Daily does not teach that each of the zones of differential breathability includes a portion of the film and a portion of the nonwoven facing material because Daily does not teach zones of differential breathability. Finally, Kitamura does not teach that each of the zones of differential breathability includes a portion of the film and a portion of the nonwoven facing material because Kitamura does not teach zones of differential breathability.

Therefore, the prior art does not teach all of the claim limitations and this rejection should be withdrawn.

**B. Kitamura, et al. do not teach “selective stretching”**

Applicants’ independent claims, 1, 30 and 41 each require that the laminate is “selectively stretched” to forms zones of differential breathability.

On page 3 of the Final Office Action, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made “to make the zones of differential breathability from any suitable method, such as by selective stretching, as taught by Kitamura, because stretching is capable of forming the differential zones of breathability.” [Emphasis added.]

Applicants respectfully disagree that Kitamura et al. teach “selectively stretching” a laminate to form zones of differential breathability. The Specification defines “Selectively stretched” on page 8 as follows:

“Selectively stretched” refers to stretching certain regions of a material to a greater extent than other regions of the material. The selection of the regions to be stretched to a greater extent can be strategically planned based on a desired level of breathability in those regions of the material, with the regions stretched to a greater extent having higher breathability than the regions stretched to a lesser extent.”

Kitamura et al. disclose a breathable film. Breathability is imparted to the film by uniaxially or biaxially stretching. (Col. 4, lines 2-3). Kitamura, et al. do not

suggest selectively stretching the film to achieve different zones of breathability within the film.

By stating that Kitamura et al. teaches selective stretching, the Examiner is making a broad conclusion that stretching a film to initially impart uniform breathability across the film is equivalent to selectively stretching a laminate to enhance the breathability of selected zones within an already uniformly breathable starting film component of the laminate. Kitamura et al. provides details in Column 4, line 4, to Column 5, line 12 on how to achieve stretching uniaxially or biaxially to impart breathability to an initially non-breathable film. However, Kitamura does not teach stretching only certain regions of the film to a greater extent than other regions of the film. Therefore, Kitamura does not teach “selective stretching” as defined by Applicants’ Specification, and as required by Independent Claims 1, 30 and 41.

The Examiner does not point to any specific passage within Kitamura et al. that teaches “selective stretching.” “Selective stretching” does not constitute “any suitable method” to make zones of differential breathability because Kitamura, et al. do not teach selective stretching.

Rather, Kitamura et al. describes the basic premise and general state of the art of combining a polymeric resin and a filler to form a film, and imparting breathability uniformly across a film by the use of stretching. More specifically, Kitamura et al. provide a teaching for “a breathable film which has not only excellent film moldability and film stretchability but also high breathability, good touch and appearance and high strength” as it had been previously recognized that “techniques to increase the breathability ... decrease film moldability and the strength of formed films, and thus, are limited in their use.” (Col. 1, lines 5-40).

This concept of uniform stretching of a film to impart breathability to a non-breathable starting film is well known in the art. Applicants’ Specification recognizes this uniform stretching and explains the difference between uniform stretching and differential or selective stretching. As stated in the Specification: “The film 32 can be initially uniformly stretched to impart a moderate level of breathability across the film 32.” (Specification, page 15, lines 4-10). “After the film 32 and the facing material

12 are bonded, the laminate 40 can be stretched in some or all areas of the laminate 40 to impart higher breathability in the stretched zones.” (Specification, page 10, lines 18-20). Thus, Applicants’ starting film (which is a component of the laminate) is already breathable prior to selectively stretching the laminate. The second stretch (*i.e.*, the “selective stretching”) of the film within the laminate is used to alter or enhance the breathability in selected zones of the laminate. Kitamura et al. do not suggest selectively stretching a film that is already breathable or that the breathable film taught therein can be selectively stretched in one or more regions to achieve differential breathability. Therefore, Kitamura et al. teach only uniform stretching.

Furthermore, Kitamura et al. does not teach uniformly stretching or selectively stretching a laminate.

For at least these reasons, this rejection should be withdrawn.

### **C. The Examiner used Hindsight**

Another criterion for establishing a prima facie case of obviousness is that there must be a reasonable expectation of success. Absent impermissible hindsight, a person skilled in the art would not logically combine the teachings of Dobrin with the teachings of Kitamura et al. and Dailey et al. to render Applicants’ claimed invention.

Applicants state that the Examiner has not provided a proper motivation to combine the references.

On pages 7-8 of the Office Action, the Examiner states “Considering that the breathable laminate of Dailey does not comprise a narrow piece of film on top of a wider piece of nonwoven web, as used by Dobrin to produce zones of breathability, it would have been necessary and thus obvious to look to the prior art for another method to impart the laminate of Dailey with zones of breathability. Kitamura provides this teaching, showing that it is known in the art to stretch a film to impart breathability thereto. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the laminate of Dailey with zones of breathability by selectively stretching, as taught by Dobrin in view of Kitamura,

motivation by the expectation of successfully forming the zones of breathability taught by Dobrin.”

As stated previously, Kitamura, et al. do not teach or suggest selective stretching. Furthermore, there is no suggestion in either Kitamura et al., Dobrin or Dailey, alone or in combination, that using differential stretching will achieve zones of differential breathability within a laminate. Thus, in the combination of Dailey et al., Dobrin and Kitamura et al. there is no teaching or suggestion to make Applicants’ claimed invention, nor is there any reasonable expectation of success.

The Examiner contends that a person having ordinary skill in the art would have been motivated (from the teachings of the references themselves and without the use of impermissible hindsight) to combine the Dailey, et al., Dobrin and Kitamura et al. references to provide the laminate of Dailey, et al. with zones of differential breathability wherein each of the zones of differential breathability comprises a portion of the film and a portion of the nonwoven facing material by providing zones of differential breathability taught by Dobrin by means of stretching the film to impart breathability taught by Kitamura, et al. Applicants respectfully disagree with the proffered motivation. Applicants’ starting film component of the laminate is already breathable and such breathability in the film had already been imparted by some stretching process akin to that taught by Kitamura, et al. Therefore, one skilled in the art would not have looked to Kitamura, et al. for “selective stretching” as a way to provide zones of breathability, as the Examiner contends, because the Kitamura, et al. teaching had already been used to provide the initial breathable film component of the laminate with uniform breathability. Applicants note, as previously mentioned, that Kitamura et al. do not teach “selective stretching” to provide differential or selective breathability. Therefore, the person having ordinary skill in the art would have no motivation, or practical teachings, suggested by the references to practice the combination of the zones of differential breathability described in Dobrin, with the film stretching of a non-breathable film to impart uniform breathability described in Kitamura et al. Therefore, there is no proper motivation for a combination of the references to arrive at the present invention, and the Examiner has not set forth a proper *prima facie* case of obviousness. (MEPE 2143).

The Examiner appears to be suggesting that the film of Kitamura et al. “could be” selectively stretched to provide zones of differential breathability as taught by Dobrin. In fact, as stated above, on page 3 of the Final Office Action, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made “to make the zones of differential breathability from any suitable method, such as by selective stretching, as taught by Kitamura, because stretching is capable of forming the differential zones of breathability.” [Emphasis added.]

However, the fact that a prior art device is capable of being modified does not render a combination obvious. Rather “there must be a suggestion or motivation in the reference to do so.” In re Mills, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). In the instant case, the Examiner has pointed to no suggestion or motivation within Kitamura et al. with respect to selective stretching.

Furthermore, a Section 103 rejection “cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Similarly, in the instant case, the Examiner provided no reason why one skilled in the art, without hindsight, would have arrived at the claimed invention. In Kotzab, the Federal Circuit said that the Examiner and Board “fell into the hindsight trap.” In re Kotzab 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). In so concluding, the Federal Circuit said “The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed.” In re Kotzab 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). In the instant case, the Examiner found prior art that “in the abstract appeared to suggest the claimed limitation.” However, the

Serial No.: 09/698,595

Docket No.: KCC-15219

Examiner provided no proper motivation for a skilled artisan to make the claimed combination.

Therefore, the Examiner used hindsight in making the 35 U.S.C. §103 rejection.

For at least the reasons presented above, Applicants respectfully submit that Claims 1-44 are not rendered obvious by combining Dailey et al., Dobrin and Kitamura et al. Thus, Applicants respectfully request withdrawal of this rejection.

**Conclusion**

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner.

Respectfully submitted,



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